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| EXAMINER |
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WANG, SHENGJUN

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1617

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/964,143
Filing Date: September 25, 2001
Appellant(s): MCLAUGHLIN, JAMES HUGH

Richard N. Miller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 24, 2004.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 3, 6, 7, 33, 39-43 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

| | | |
|---------------------|----------------|-------------------|
| US Patent 6,042,815 | Kellner et al. | March 28, 2000 |
| US Patent 5,360,824 | Barker | November 1, 1994 |
| US Patent 6,153,208 | McAtee et al. | November 28, 2000 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 3, 6, 33, 40-43 are rejected under 35 U.S.C. 103(a) over Kellner et al. in view of Barker et al
2. Claims 7 and 39 are rejected under 35 U.S.C. 103(a) over Kellner et al. in view of Barker et al, and further in view of McAtee

These rejections are fully set forth in prior office action, mailed March 24, 2004 and reiterated below.

(11) Response to Argument

1. Claims 3, 6, 33, and 40-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner in view of Barker et al.

Kellner teaches water and oil emulsion solid cosmetic compositions. The composition comprising up to 30% of emollient oil, both natural and synthetic oil may be employed (see, particularly, col. 9, line 29 to col. 11, line 62. Kellner further discloses that additional emollient materials, such as fatty alcohol, wax, etc., as oil phase gelling agent may be employed up to 30% (see, particularly, col. 2, lines 66-67; col. 7, line 45 to col. 9, line 26). Kellner further teaches that up to 20 % of primary gelling agent may used, wherein the preferred primary gelling agent is salt

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of fatty acid, particularly, calcium stearate (see col. 2, lines 24-65). Surfactants up to 20% are desirable in the composition. Surfactants, including cationic, anionic nonionic and zwitterionic surfactants are suitable (see, col. 16, line 9 to col. 19, line 34). The composition may comprise up to 50% of particulate matter, the particulate matter may be organic or inorganic, such as corn starch, mica, talc, etc. (see col. 19, lines 37-61). The water in the composition may range from 5% to 95% (see particularly, the claims).

2. Kellner does not teach expressly the particular percentage of each and every ingredient herein claimed, or the employment of particular ingredients, such as corn starch, calcium stearate, or the employment of sodium chloride as a particulate ingredient.

3. However, Barker teaches that sodium chloride particulate are known to be useful in cosmetic composition as particulate ingredients (see claim 5).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a composition with the particular percentages of each and every components herein since the percentage range herein defined are either encompassed by, or overlapped with the range disclosed by Kellner. Note it is well settled that in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Also see MPEP 2144.05. The employment of the particular ingredients such as corn starch or calcium stearate is obvious since they are known to be useful in the composition. The employment of such components in the composition is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388). The employment of sodium

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chloride is obvious because sodium chloride particulate is known to be useful in cosmetic composition.

4. Claims 7, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellner for reasons discussed above, and in further view of McAtee et al. ((US 6,153,208, claim 7).

5. Note Kellner does not teach expressly the employment of the particular oil, or surfactant herein.

However, McAtee disclosed that sodium cocoyl methyl taurate is similarly useful as other anionic surfactant in cosmetic composition. (col. 20, lines 1-13).

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ sodium cocoyl methyl taurate because sodium cocoyl methyl taurate is known to be useful as anionic surfactant in cosmetic composition.

Appellants argue that the claimed invention is not obvious over Kellner et al. Specifically, appellants argue that

(1) Kellner compositions are in the form of solid or stick (col. 1, lines 29 - 53, the 13 examples and claim 1) and Appellant's compositions are in the form of cream or extrudable paste (page 11, line 17, and claim 40).

(2) The Kellner composition are oil-in-water or water-in-oil emulsions (col. 1 line 56 and claim 1) and Appellant's compositions are suspensions of particulates in emollient materials thickened with particles of calcium or magnesium C14 - C18 monocarboxylic acid salt (page 4, line 18, page 10, lines 29 - 31, and claim 40).

(3) Kellner's compositions are used to deliver pigments to the skin (claim 1 and

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Appendix B) and, optionally, to moisturize the skin (col. 1, lines 40 - 41), whereas Appellant's compositions are effective to cleanse the skin (page 11, lines 16 - 24) and condition the skin by depositing fatty matter on the skin (page 6, lines 5 - 10).

(4) Kellner's concentration of surfactant is controlled to facilitate wetting of pigments being delivered to the skin (claim 1 and col. 11, lines 65 - 66, and Appendix D); whereas, Appellant's surfactant concentration is controlled to deliver a controlled amount of emollient material to the skin (page 6, lines 10 - 22).

(5) One object of Kellner is stick compositions which contain "appreciable amounts of water" (col. 1, lines 34 - 35 and 43-44) and the thirteen Kellner examples contain 37.7% - 50.4% by weight of water; whereas, Appellant's compositions contain 0% to 10% by weight water (page 13, lines 7 - 8).

The rebuttal arguments are not persuasive for following reasons:

(1) Kellner et al. provide six objects (see column 1, lines 36-54). First two objects encompass "solid" cosmetic composition which provide cooling feel to the skin, a smooth texture finish when applied to skin, and are capable of moisturizing the skin. Note "solid" therein is defined as solid or semi-solid. See column 2, lines 6-9. The solid disclosed by Kellner et al. is actually a gel, which would meet the limitation of "extrudable paste."

(2) the cosmetic composition disclosed by Kellner et al. may comprise substantially amounts of particulate matters (up to 50%). Even Kellner et al. do not expressly state the composition is a suspension, one of ordinary skill in the art would understand that, with such amounts of particulate matters, the composition would have been reasonably considered as a suspension. Further, claims as appealed do not have the limitation regarding emulsion and/or

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suspension. It is noted that the features upon which applicant relies (i.e., a suspension, not an emulsion) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(3) Kellner's composition is not limited to delivery of pigments, but also to provide stable composition suitable for skin conditioning. See, column 1, lines 35-55, and col. 20-22, wherein a variety of skin conditioning agents are disclosed. Further, it is well settled that the "intended use" of a product or composition will not further limit claims drawn to a product or composition. See, e.g., *In re Hack* 114 USPQ 161.

(4) The intended function of an ingredient in a composition is not seen to further limit the composition. Further, it is well settled that "As long as some motivation or suggestion to combine the references is provided by the prior art taken as whole, the law does not require that the references be combined for the reason contemplated by the inventor." *In re Beattie* 947 F.2d 1312 (Fed. Cir. 1992). In the instant case the 0.4-8% surfactant herein claimed would have been obvious over 0.1-20 % of surfactant taught by Kellner et al. even though Kellner may reach the particular percentage herein by a reasons not contemplated by appellants.

(5) The "appreciable amounts of water" employed by Kellner et al. is defined as 5-95% of water. The amount of water employed herein (0-10%) would read on that "appreciable amounts of water."

Appellants further argue that the examiner's reading of Kellner's teaching is overly broad. Specifically, appellants contend that Kellner et al. as a whole only teaches sodium stearate as useful in the composition disclosed therein, and the examiner should not interpret that Kellner

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et al. teach sodium stearate and calcium stearate are equivalent, even Kellner though specifically, claim calcium salts of fatty acid. The examiner respectfully disagrees. Note question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Appellants may not ignore the full scope of Kellner's teaching. Further, one of ordinary skill in the art would not have interpreted Kellner's teaching as sodium stearate and calcium stearate are exactly the same. Selection within the disclosed scope according to a particular composition would have been considered within the skill of the artisan. Kellner et al. teaches that both sodium and calcium stearate are suitable for the composition disclosed therein. See, column 1, lines 57-63 and claims 4. The examiner does not dispute that sodium stearate and calcium stearate are not equivalent as gelling agents in a composition comprising 41% of water as shown in the 1.132 Affidavit. The examiner contends that it would have been obvious to one of ordinary skill in the art to use calcium stearate in the composition of Kellner et al., wherein the water amount is 5-10%.

For the above reasons, it is believed that the rejections should be sustained.

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SHENGJUNWANG
PRIMARY EXAMINER

Respectfully submitted,

Shengjun Wang
Primary Examiner
Art Unit 1617

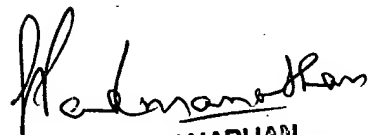
March 21, 2005

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